



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,704	11/12/2002	John S. Fisher	1139.23	4253

21901 7590 12/30/2004

SMITH & HOPEN PA
15950 BAY VISTA DRIVE
SUITE 220
CLEARWATER, FL 33760

EXAMINER

JUNG, WILLIAM C

ART UNIT PAPER NUMBER

3737

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,704

Applicant(s)

FISHER ET AL.

Examiner

William Jung

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-31 and 37 is/are allowed.
- 6) ☒ Claim(s) 1-4, 32-36 and 38-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-4, 32-36, 38-45, and 46-84 are rejected under 35 U.S.C. 102(a) as being anticipated by *Fogarty et al* (US 6,405,733).

Fogarty et al anticipate all claimed features in claims 1-4, 32-36, 38-45, and 46-84

Claims 1, 46, 52, 78, 79, 81-84: Fogarty et al disclose an apparatus and method for marking a biopsy site, which includes a marker at the distal end of the catheter and attachment member which can be configured to form J-hook or barb (see figures 3 and 7) and be fixedly attached to a target tissue site where the biopsy is being performed. (col. 3, lines 42-55; col. 4, line 15 – col. 5, line 65; col. 8, line 42 – col. 9, line 39).

Claims 32, 38, 44, 58, 64, and 72: In addition, the biopsy needle in the catheter is delivered to the tissue site via plunger disposed within a lumen as shown in figures 11-17

Claims 2-4, 33-36, 39-42, 47-50, 53-56, 59-62, 65-71, and 73-76: Furthermore, Fogarty et al disclose that the locator or marker element is made of biocompatible or biologically absorbable material with attachment by metal wires, polymers, etc. (col. 13, lines 30-58).

Claims 43, 45, 51, 57, 63, 77, and 80: Moreover, Fogarty et al disclose that the marker attachment member is flexible and resilient material so that it can be configured to desirable shape (col. 15, lines 21-53).

Art Unit: 3737

Allowable Subject Matter

3. Claims 5-31, 37 allowed.

Fogarty et al described above do not teach or suggest obviousness to further include marking tissue by fixedly attaching the marker by forming a blind bore having a concave bottom, introducing the tissue marker and biopsy needle to a side port and applying a vacuum to the biopsy needle to pull the tissue into the lumen. In addition, Fogarty et al do not teach an use of clip having fixed securely to an annular or cross shape cavity where a second bore is formed in the clip.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Foerster et al (US 6,228,055), *Sirimanne et al* (6,356,782), *Hussman* (US 5,782,771), and *Morcos et al* (US 5,865,738).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 571-272-4739. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WCS
December 13, 2004

Eleni Mantis-Mercader
ELENI MANTIS-MERCADER
PRIMARY EXAMINER